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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,442	09/08/2003	Dov L. Randall	0112300-1627	1420
29159 7590 02/04/2009 BELL, BOYD & LLOYD LLP P.O. Box 1135 CHICAGO, IL 60690				
EXAMINER RENDON, CHRISTIAN E				
ART UNIT		PAPER NUMBER		
3714				
NOTIFICATION DATE		DELIVERY MODE		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATENTS@BELLBOYD.COM

### Office Action Summary

**Application No.**

10/657,442

**Applicant(s)**

RANDALL ET AL.

**Examiner**

CHRISTIAN E. RENDÓN

**Art Unit**

3714

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6-12, 14-21, 23-31, 33-40, 42-51 and 53-67 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-12, 14-21, 23-31, 33-40, 42-51 and 53-67 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Final Drawing Review (PTO-849)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

This office action is in response to the amendment filed on 10/23/08 in which applicant amended claims 1, 4, 10, 18, 21, 29, 37-38, 40, 48, 56-58, 60-62, 66-67; responds to claim rejections. Claims 1-4, 6-12, 14-21, 23-31, 33-40, 42-51, 53-67 are still pending.

### *Claim Rejections - 35 USC § 103*

**Claims 1-4, 6-12, 14-21, 23-31, 33-40, 42-51, 53-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baerlocher et al. (US 2003/0036419 A1) in view of one having ordinary skill.**

1. Regarding claims 1, 10, 18, 29, 37, 48, 56-58, 62 and 66-67, Baerlocher discloses a primary or triggered bonus or secondary game that randomly generates or **selects a plurality** of digits of an **award** (abstract). The game instructs the player to use the three digits to create an award (fig. 3b-c) from a range of possible **award values** or offers which will all consist of the **same number of digits**. Therefore the game presents a number of digits that are **statically associated with an offer component**, the box that outlines the value. The game machine's **processor is programmed** to randomly generate **offer components** or digits for activation (par. 10, lines 5-6). A player **determines an offer based on the award value** that are determined from the **activation order of the offer components** (fig. 3D, 120) and all possible awards consist of the **same number of digits** (par. 10, lines 10-12). At this point the player is given a choice to **accept or reject the offer** (par. 18, lines 1-3). The preferred embodiment of the game randomly decides on a modification method to apply on the award **when the player rejects the offer** (par. 19, lines 2-5). Therefore at least one **component modifier is selected and displayed** (fig. 9). Once the modification process is complete, **a new award is displayed and available to the player** (par. 114, lines 6-7) for acceptance or rejection. In addition the reference states providing a display device able to present visual images

using mechanical wheels (par. 46, lines 5-9), thus teaching the use of **displaying the component modifiers through a mechanical wheel**.

2. The included modification methods that change the state of an offer component are scrambling the digits, regenerating the award, subtracting or adding a digit and multiplying an award (par. 19, lines 6-9). The subtraction of a digit is the only modification that **unselects** a number or **offer component based on the number or value of the component** (par. 22, lines 5-7), therefore it is viewed as a **modifier associated with a negative value** or effect because of the impact it creates is undesirable (par. 130, lines 6-10). The addition of a digit (par. 125, lines 11-12) will always increase the award and is highly desirable since the **modifier is associated with a positive value** or effect. Furthermore, add/subtract digit modifier are also viewed as **changing the status of an offer component based on the value (positive/negative) associated with the modifier**, as described in claims 18 and 29. As for the multiplication modifier (par. 135, lines 7-8), the game randomly selects a multiplicand and the previous offer is the multiplier. The value of a multiplicand ranges from a negative value to zero to a positive value therefore this modifier is able to produce **awards of positive or negative values using positive or negative component number modifiers**.

3. Thus the multiplication modifier is the only modifier that requires a value hence the association with a value (fig. 13). Therefore the prior art fails to teach two of the applicant's limitations: containing **only different modifying components associated with values** and **displaying all of them at once**. However the Office views the prior art's teaching of one modifying components associated with a value sufficient for one having ordinary skill in elementary math to include other mathematical operations that require values. Furthermore the Office views the limitation of a game containing only modifiers associated with a value then a mix of modifiers as taught by the prior art as mere design choice. Since the same problem of providing a consequence for rejecting an award is still solved by both games. Additionally the displaying of all possible modifiers at once to a player is also viewed as

mere design choice since in both games the player has no say in which modifier will be used therefore each game takes a different approach on 'building suspense' as unknown (prior art) or identified (applicant) consequences.

4. Regarding claim 2, 11, 19, 30, 38, 49, 61 and 65, figure 8 of the prior art demonstrates the occurrence of an event that allows the player to **accept** [keep] (fig. 8, 166) or **reject** [modify] (fig. 8, 164) an offer provided by the preferred embodiment (par. 19, lines 2-5).
5. Regarding claims 3-4, 12, 20-21, 31, 39-40 and 50-51, in one of the preferred embodiments the game displays three **masked** numbers (Fig. 3B, 116) (par. 56, lines 6-8) or **offer components** since each one is a piece of a final offer. A player is allowed to decide how to organize the pieces or components by selecting or activating a masked number's digit location.
6. Regarding claims 6-8, 14-16, 23-25, 33-35, 42-44 and 53-55, the prior art illustrates in figure 5 that a **probability is associated with each offer component** or masked number and is stored in a database (par. 77, lines 1-2). The numbers are all weighted differently and the game machine is programmed to assign 50% of the time 0-3 as an offer component (par. 78). Therefore a player is more likely to receive an award of lower value thus **less likely to receive a greater award**.
7. Regarding claim 9, 17, 26, 36 and 45, the game machine offers awards associated with each offer component and the total **range of possible awards** is equal to  $^{10}P_3 = 720$ .
8. Regarding claims 27-28, the prior art discloses a **selector** or **modify button** that selects from several modification methods when a player rejects an award (par. 19, lines 2-5).
9. Regarding claim 46, the art discloses several possible modifiers that the game can select from and each possible modifier has a value or effect attributed to each one. As stated above, addition and multiplication always have positive effects, regeneration and scrambling are considered to have neutral effects since a player cannot allow depend on positive results and subtraction of a digit

always has negative effects. Therefore the prior art discloses a game **selecting a modifier from a range of effects** or values.

10. Regarding claim 47, the prior art claims that each possible modifier is **selected based on a probability stored in a memory device** (par. 112, 119, 124, 129, 134, lines 1-3).

11. Regarding claims 59-60 and 63-64, the art discloses a modification that subtracts a digit, in other words unselects a number or offer component based on the number or value of the component (par. 22, lines 5-7). Since the value of an award is always lowered this **modifier is associated with a negative value** or effect and is considered very undesirable (par. 130, lines 6-10). Fortunately, the modifier **deselects the number** of the lowest value (par. 22, lines 5-7); therefore the offer component that contains the lowest number is associated with the negative value attributed to this modification.

### ***Response to Arguments***

12. Applicant's arguments with respect to all the claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Previous Arguments***

13. Applicant's arguments filed on 6/25/08 have been fully considered but they are not persuasive. The amendments made to the claims were addressed in the Office Action, please see above. The applicant argues the importance in showing the possible component number modifiers in a player deciding to risk an offer. The Examiner has already previously acknowledged the psychological effects of display or not displaying the modification methods as invoking the same sense of suspense towards the possibility of obtaining a higher offer. Furthermore the Examiner sees no patentable weight in displaying all of the component modifiers since it is an obvious alteration. Regarding the Applicant's request for suggestions or identifying patentable subject matter, the Examiner has nothing to offer towards both requests. One final note for the record, during the interview on 6/3/08 with Mr. Abern, Mr. Abern acknowledged the prior art teaching the gameplay methodology of the applicant's

limitations when asking the Examiner to identify any allowable subject matter. Therefore it is possible for the applicant to disagree with this statement since these current arguments are made by Mr. Masia.

### ***Conclusion***

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **CHRISTIAN E. RENDÓN** whose telephone number is (571)272-3117. The examiner can normally be reached on 9 - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dimtry Suhol can be reached on 571-272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dmitry Suhol/  
Supervisory Patent Examiner, Art Unit 3714

/CHRISTIAN E RENDÓN/  
Examiner Art Unit 3714

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